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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,883	10/29/2003	Nobuyuki Akai	OGA-208-USAP	4096

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,883

Applicant(s)

AKAI, NOBUYUKI

Examiner

Philip R. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

- [01] Outstanding claim rejections have been withdrawn.

Claim Rejections - 35 USC § 102

- [02] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [03] Claims 1, 4 & 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuji.

Response to Arguments

- [04] Applicant's arguments filed 4/19/2006 have been fully considered but they are not persuasive.
- [05] Applicant firstly contends that in previous amendments, Applicant has "narrowed the claims to the term "surge absorber," thereby excluding air gaps (which may be a form of capacitor)." It is respectfully maintained that striking a phrase from the claims does not "exclude" any anticipatory element which may be disclosed in the Prior Art; and furthermore, that the capacitor disclosed by Tsuji anticipates a surge absorber.
- [06] Applicant secondly contends that the term "surge absorber" has taken a meaning in the art separate from that of a capacitor. It is maintained that the meaning are at least overlapping in scope, given that a capacitor is capable of absorbing a surge.

[06a] Applicant provides evidence in the form of a dictionary definition, stating that the definition "requires dissipation of the energy of a surge." This is a mischaracterization: the evidence provided states that a surge absorber "diverts, and may partly dissipate, the energy of a surge." It is maintained that diversion of energy is precisely what a capacitor does. According to Merriam-Webster Online, a capacitor diverts "electrical energy of [a] charged system" where it is "stored in [a] polarized dielectric" (<http://www.webster.com/dictionary/capacitor>).

[06b] Applicant provides further evidence in the form of patent publications and other literature. Applicant convincingly argues that a surge absorber may be variously assembled of, for example, varistors and gas arrestors. However, none of the evidence provided excludes a capacitor from the family of components which are capable of absorbing a surge.

[06c] Applicant reiterates that "it is required that the surge absorber dissipate energy." Without conceding that a capacitor does not "dissipate energy," it is respectfully maintained that a capacitor does "divert" energy, thus anticipating a surge absorber.

[07] Applicant lastly contends, convincingly, that "[i]t is well established... that terms in a specification are to be given their ordinary meaning." With this in mind, the following are provided as evidence that surge absorbance is commonly attributed to a capacitor:

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[07a] 6,064,578 Hashimoto: "...capacitor 8 ... serves as a filter capacitor and absorbs surge voltage..." (21/13-15);

[07b] 5,949,197 Kastner: "Capacitor C1 absorbs sufficient energy during some power surges to allow power supply 10 to survive undamaged" (6/25-28);

[07c] 5,701,071 Liou: "The bypass capacitor also absorbs excess energy coupled to the chip from the external supply lines to minimize voltage surges" (2/33-35);

[08] In summary, the recited "surge absorber" does not patentably distinguish the claimed invention from Tsuji's disclosed capacitor, an element inherently capable of absorbing a surge; nor does the specification impart a narrower definition; nor do the ordinary meanings of the terms "capacitor" and "surge absorber" preclude one another.

Conclusion

[09] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

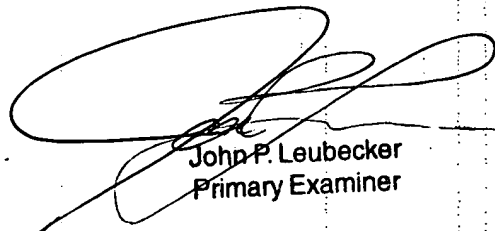
[10] A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

- [11] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [12] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [13] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

prs



John P. Leubecker
Primary Examiner